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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,790	04/02/2004	Yutaka Kanamaru	1422-0416PUS2	9926
2292	7590	01/10/2005		EXAMINER
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				RODEE, CHRISTOPHER D
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

ID

Office Action Summary	Application No.	Applicant(s)	
	10/815,790	KANAMARU ET AL.	
	Examiner	Art Unit	
	Christopher RoDee	1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 03 December 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 11, 13, 14 and 16-18 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 11, 13, 14 and 16 is/are allowed.

6) Claim(s) 17 & 18 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant claims have been amended to specify a polymerization initiator as a component of the toner's resin binder. This amendment appears to have been made in response to the rejection under this section and paragraph presented in the last Office action. The amendment does not resolve the issue as previously presented and introduces a new issue of new matter because the specification as filed does not disclose a polymerization initiator as a component of the resin binder (i.e., the produced resin).

The specification does teach the hybrid resin is "obtained by mixing a mixture comprising raw material monomers for a resin and raw material monomers for polycondensation addition polymerization resin, and carrying out two polymerization reactions in one reaction vessel." In such a reaction the initiator would be consumed in order to form the resin binder (see spec. p. 9). There is no indication in the specification as filed that there is any residual (i.e., unreacted) initiator remaining in the toner's resin binder. The claims explicitly require the presence of initiator in the binder, but there is no basis in the specification for such a limitation. The claims as now presented include new matter. Further, the claims remain without basis for the same reasons as given in the last Office action because the amendment does not resolve the previously discussed issue of new matter.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki *et al.* in US Patent 5,723,246 in view of Matsunaga *et al.* in US Patent 5,976,752.

This rejection was presented in the last Office action. The instant claims have been amended to require a polymerization initiator in the as a component of the binder resin. Although Aoki does not disclose such a feature, it appears that this amendment was intended to place the initiator in the reaction portion of the claims (i.e., the "obtained" limitation). This rejection is presented on the presumption that the claims will be amended to include the initiator in the manner suggested in the last Office action. Aoki discloses a polymerization initiator as a component of the reaction composition in Table 2 where dicumyl peroxide is recited.

Applicants traverse this rejection as set forth because Aoki provides no motivation to arrive at the claimed toners and that Matsunaga does not remedy this deficiency (response p. 11). This is not a persuasive argument because there is no discussion of the specific teachings of the references. Applicant's provide a conclusion without providing any discussion why the references in combination fail to suggest the claimed invention.

As noted previously, Aoki discloses a toner comprising a binder resin having the following three resins (A) to (C): resin (A) having a softening point of 120 °C or more and 170 °C or less, a glass transition temperature of 58 °C or more and less than 75 °C, and a weight percentage of components insoluble to chloroform at 25 °C of 5% by weight or more and 50% by weight or less and resin (B) having a softening point of 90 °C or more and 120 °C or less, a glass transition temperature of 58 °C or more and less than 75 °C, and a weight percentage of

components insoluble to chloroform at 25 °C of less than 5% by weight. Aoki is particularly interested in obtaining low-temperature fixing ability, offset resistance, and blocking resistance (col. 3, l. 36-39). Waxes, such as polyolefins, are suggested for use in the toner to acts as offset inhibitors (col. 12, l. 40-56) and are present in an amount of from 1 to 5 parts per 100 parts of the binder resin (col. 12, l. 40-42). Aoki does not disclose the claimed wax, but Matsunaga discloses the usefulness of incorporating a wax having a DSC heat absorption peak in the range of 70 to 160 °C, preferably 80 to 135 °C (col. 16, l. 12-37), to provide anti-offset properties, low temperature fixibility, and antiblocking performance. The combined references would have suggested the claimed invention because Matsunaga teaches that waxes according to that invention provide anti-offset properties, low temperature fixibility, and antiblocking performance and these characteristics are desired by the primary reference. The artisan would also have found it obvious to use combinations of condensation resins, such as polyesters, with hybrid resins because the reference teaches that both are useable independently for the resins of that invention and noting the resin combinations in the Examples (see Tables 1-3).

The evidence of record is not persuasive to overcome this rejection because no evidence appears to be of record that reproduces the examples of Aoki. Further, the claims are broader than the showing because the claims permit any amounts of the respective resins while the recent declaration is limited to a specific ratio of resins (see declaration Table C).

The rejection is seen as proper and is maintained.

Allowable Subject Matter

Claims 11, 13, 14, and 16 are allowed. The amendments to claim 11 and the newly submitted declaration under Rule 132 are sufficient to overcome the previously applied rejections for these claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1756

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



cdr
6 January 2005

CHRISTOPHER RODEE
PRIMARY EXAMINER